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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/727,491	CHEN ET AL.	
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 7/6/04 to the application filed on 12/04/00.

2. Claims 1-20 are pending in the case. Claims 1, 11, 14 are independent claims.

3. The objections of figures 1, 3-5 have been withdrawn in view of the submission of the new figures 1 and 5. However, the objection of figure 6 as not being legible remains since there is no submission of the readable version of figure 6.

4. The objection of the specification has been withdrawn in view of the update of the status of the related application.

5. The rejections of claims 1-20 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of the amendment.

Drawings

6. The drawings remain objected to for the following reasons: figure 6 is not legible. Submission of a readable version of figure 6 is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 remain provisionally rejected under the judicially created doctrine of double patenting over claims 1-6, 10-13, 18-21, and 27 of copending Application No. 09/727,524. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

'524 discloses:

- creating a multimedia description file in a template for formatting multimedia content (claim 1, step b as amended)
- combining the multimedia description file of selected stored multimedia assets and the multimedia content description file to create a multimedia repository file executable on a multimedia player (claim 1, step c as amended)
- creating an extensible markup language-based multimedia repository file using a text editor (claim 3 as amended)
- operating the processor in a batch mode to combine the multimedia repository file of selected stored multimedia assets and the multimedia content description

file into a multimedia repository file executable on a multimedia player (claim 4 as amended)

- injecting content into the multimedia content description file by users (claim 2: editing content into the multimedia description file by a user implies injecting data to the multimedia description file since editing includes adding data)
- the multimedia repository file is a multimedia container in a binary format (claim 10)

'524 does not disclose:

- accessing the multimedia assets using a processor as an authoring tool to create a multimedia repository file of selected stored multimedia assets in a text based format

However, '524 discloses:

- creating a multimedia content file from rich media content as a first input to an authoring tool (claim 1, step a as amended)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified '524 to include said accessing above since creating a multimedia content file from rich media content suggests accessing the multimedia assets having the rich media content, for getting multimedia to create the multimedia file.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 6, 9-12, 14, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gibbon (US Pat No. 6,473,778 B1, 10/29/02, filed 2/1/99, priority 12/24/98).

Regarding independent claim 1, Gibbon discloses:

- accessing the multimedia assets using a processor as an authoring tool to create a multimedia repository file of selected stored multimedia assets in a text based format (col 3, lines 18-28, 45-57, col 2, lines 8-12, figure 9 and col 13, line 53 to col 14, line 7: *accessing a large multimedia database* using *standard text* information retrieval system, selecting the best multimedia data for creating the content of a multimedia file)

- creating a multimedia description file in a template for formatting multimedia content (figure 9, col 13, line 53 to col 14, line 7)
- combining the multimedia repository file of selected stored multimedia assets and the multimedia content description file a multimedia repository file executable on a multimedia player (figure 9 and col 13, line 53 to col 14, line 7: selecting a template to apply the linked media in text description file and image description file to the template for rendering a hypermedia document to users)

Regarding claims 2 and 9, which are dependent on claim 1, Gibbon discloses injecting other content into the multimedia content description file (col 5, lines 1-19: placing anchors elsewhere in the text, modify the list to improve the document layout; col 2, lines 8-12: generating a hypermedia document in response to the user request using a selected template implies that the multimedia content must be injected into the template, which is equivalent to the multimedia content description file, for said generating).

Regarding claim 6, which is dependent on claim 1, Gibbon discloses managing the creation of the template and the multimedia content description file in stages by different users (figure 9 and col 13, line 53 to col 14, line 7, col 2, lines 8-12).

Regarding claim 10, which is dependent on claim 1, Gibbon discloses that the multimedia repository file is a multimedia container in a binary format (col 11, lines 63-67: since the video frames extracted in digital format via the analog-to-digital converter,

the multimedia file including video frames should also be in digital format, that means in the 1s and 0s of binary numbers).

Claims 11-12 are for a system of method claims 1 and 6 and are rejected under the same rationale.

Claims 14, 18 are for a program medium of method claims 1-2, 6, and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 7-8, 13, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon ((US Pat No. 6,473,778 B1, 10/29/02, filed 2/1/99, priority 12/24/98).

Regarding claims 7 and 8, which are dependent on claim 1, Gibbon does not explicitly disclose operating the processor in a batch mode to combine the multimedia repository file of selected stored multimedia assets and the multimedia repository file executable on a multimedia player.

However, Gibbon provides an *automated* method and an *automated multimedia authoring tool* for creating hypermedia documents from conventional transcription of television programs wherein a hypermedia document is created by inserting multimedia content into the template (col 2, lines 46-53, figure 9, and col 13, line 53 to col 14, line 7). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gibbon to include a batch mode when operating to combine the template and the media content since the automated feature in Gibbon suggests that the combining step is performed automatically as in the batch mode wherein the steps of the program are set up to *run automatically* without user intervention.

Claim 13 is for a system of method claim 7, and is rejected under the same rationale.

Claims 19-20 are for a program medium of method claims 7-8, and are rejected under the same rationale.

14. Claims 3-5, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon as applied to claims 1 and 14 above, and further in view of Hui (US Pat No. 6,654,030 B1, 11/25/03, filed 3/31/99).

Regarding claim 3, which is dependent on claim 1, Gibbon does not disclose creating an XML based MVR file.

Hui discloses a XML-based video file (figure 1 and col 2, line 59 to col 3, line 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Hui into Gibbon since the XML-based video file in Hui suggests creating a multimedia file in XML-based format, providing the advantage to apply the XML-based format instead of the HTML-based format to the multimedia file in Gibbon (figure 9) for enhancing the display of multimedia files on the web such as synchronizing the video files, a feature that HTML does not provide to multimedia.

Regarding claim 4, which is dependent on claim 1, Gibbon does not disclose using a textual editor to create an MVR-XML file.

Hui discloses a XML-based video file (figure 1 and col 2, line 59 to col 3, line 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Hui into Gibbon since the XML-based multimedia file would provide the advantage to apply to the HTML-based multimedia file, which is also in markup language-based for conveying more features for a media file such as video

synchronizing, and it was well known in the art that the multimedia file in XML or HTML format, which is a text file, is created using any text editor.

Regarding claim 5, which is dependent on claim 1, Gibbon does not disclose using an MVR-XML file as a data interchange among other Rich Media Content creation applications.

Hui discloses using an MVR-XML file as a data interchange among other Rich Media Content creation applications (col 4, lines 49-65 and figure 4: disk 3 has media files for different applications).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Hui into Gibbon since Hui discloses using an MVR-XML file as a data interchange among other Rich Media Content creation applications providing the advantage to replace the MVR-HTML file in Gibbon for advanced features for video files such as video synchronizing.

Claims 15-17 are a medium of method claims 3-5, and are rejected under the same rationale.

Response to Arguments

15. Applicant's arguments filed 7/6/04 have been fully considered but they are not persuasive.

Regarding the double patenting rejections, Applicants assert that claims 1-6, 10-13, 18-21, and 27 of the co-pending application 09/727,524 fail to recite the elements of

amended claims 1-20 of the present invention. More specifically, the claims of the co-pending application fail to recite at least the creation of a multimedia description file in a template, as well as the combination of a multimedia repository file of selected stored multimedia assets and the multimedia content description file to create a multimedia repository file executable on a multimedia player (Remarks, page 8).

Examiner respectfully disagrees.

The claims of the co-pending application '524, *as amended*, recite: a) creating a multimedia content file from rich media content, b) creating a text based rich media content description file descriptive of the multimedia content file, c) combining the multimedia content file and the text based description file as a composed file.

Clearly, the multimedia content file from rich media content of '524 is equivalent to the multimedia repository file of the present invention since both these files are files of multimedia data selected from the multimedia assets.

And clearly, combining the multimedia content file and the text based description file as a composed file in '524 is also equivalent to combining the multimedia repository file of selected stored multimedia assets and the multimedia content description file to create a multimedia repository file since this is a combination between the multimedia data and the description file.

Applicants argue that Gibbon fails to disclose at least accessing of multimedia assets, creating of a multimedia repository file of selected stored multimedia assets in a text based format, creating of multimedia description file in a template for formatting

multimedia content, and combining of the multimedia repository file of selected multimedia assets and the multimedia description file to create a multimedia repository file executable on a multimedia player (Remarks, page 9).

Examiner respectfully disagrees.

Gibbon discloses the argued limitations as disclosed in the claim rejections above.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maxwell et al. (US Pat No. 6,589,290 B1, 7/8/03, filed 10/29/99).

Nishi (US Pat No. 6,681,395 B1, 1/20/04, filed 3/18/99).

Hobbs (US Pat No. 6,523,022 B1, 2/18/03, filed 7/7/99).

Gatzemeier et al., Making Complex Document Structures Accessible through

Templates, ACM 2000, pages 509-519.

Floyd, Processing Templates in XSL, Web Techniques, July 1999, pg. 44, 4 pgs.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh
1/14/05

STEPHEN HONG
SUPERVISORY PATENT EXAMINER